

REMARKS

The present Amendment, for which a one-month extension is hereby requested, is responsive to the final Official Action mailed on December 19, 2003, and is accompanied by a Request for Continued Examination. The Office Action rejected claims 4-14, 71-79, 81, 82, and 89-94, objected to claim 80, and withdrew claims 33-51 from consideration. Although the Applicant does not agree with either the withdrawal of claims 33-51 or the basis on which this withdrawal has been made, in order to facilitate the application process, claims 33-51 are cancelled by the present Amendment. Claim 80 has been rewritten in independent form by incorporating its underlying claims, thereby conforming to the comments of the Office Action, and consequently should now be in allowable form. All of claims 4-14, 71-79, 81, 82, and 89-94 stand rejected under either 35 U.S.C. 102(e) as anticipated by Aoki et al., U.S. patent number 6,243,220, or under 35 U.S.C. 103(a) with Aoki as the primary reference. Although, as discussed in the previous Amendment, the Applicant believes these rejections to be in error, in order to facilitate the application process the independent ones of these claims have been amended to further delineate their distinctions from the prior art. Additionally, several new claims have been added.

Telephone Interview

The Applicant thanks the Examiner for the telephone interview on March 30, 2004, at which he was represented by the undersigned. The purpose the interview was to discuss, at a basic level, the present invention and how it differs from the prior art. The main topics were that when the independent claims refer to recording data on "a first medium" and "second media", the application means multiple, distinct media; that the primary reference relied upon by the Office Action (Aoki et al.) relates to reading data from a single media; and that the Applicant considers the CD/CD-ROM embodiment (as in claims 4 and 89) to be a specific example of multiple, distinct logical media stored on the same physical medium. Although the Applicant believes the claims allowable in their original form, it was agreed that they may benefit from being amended to make the distinctions over the prior art more explicit.

Aoki

All of the claims 4-14, 71-79, 81, 82, and 89-94 stand rejected under either 35 U.S.C. 102(e) as anticipated by Aoki or under 35 U.S.C. 103(a) with Aoki as the primary reference. The teachings of Aoki are all directed at reading data from a single medium (both logically and physically), where the content (both the standard audio and the supplemental audio) is read as part of a standard read process for the medium, and the supplemental audio is subsequently extracted.

Figure 2 of Aoki shows a portion of this single medium broken down into portions. As the tape is run in the direction 38, these segments consecutively pass across the read head (19, Figure 1A). As part of a single read process, the data in portions Audio Signal Area B, Video Signal Area V, Audio Signal Area A, etc. are each read in order as part of a standard read process. The additional audio information (here in the subcode area) is combined with, and obtained from the same portion of the same media in the same read as, the standard audio information. The additional information is then extracted to combine with the standard audio. In an analogous sort of CD arrangement, this would be very similar the sort of prior art described in the Background section of present application at page 3, lines 3-22.

All of Aoki's teaching are directed to a single medium (both physically and logically), where the audio (including the supplemental audio) of all the areas is stored according the medium and read sequentially as part of the single read process as is standard for the medium, with the supplemental audio is extracted from the combined audio subsequently to its being obtained in the standard read. This is respectfully submitted to be substantially different from the aspects of the present invention to which the pending claims are drawn.

(Other distinctions between Aoki and the present application are given in the previous Amendment. These will not be repeated here, both to save space and to focus on this fundamental difference between the pending claims and prior art.)

Multiple Physical Media Embodiments

Of the claims rejected in the present Office Action, the independent claims are claims 4, 7, 71, and 89. Independent claims 7 and 71 both refer to recording data on "a first medium" and "second media", by which the applications means multiple, distinct media. The Office Action (p. 11, third paragraph) has taken this to mean two different areas of the same medium: This is

incorrect. The application intends different media that are distinct logically, physically, or both. To make this more explicit, these claims have been split into multiple physical media claims and multiple logical media claims, with both of claims 7 and 71 being amended to add the language "wherein said first and second media are distinct physical media". (The multiple logical media versions occur as new claims 107 and 117, discussed in the next section.)

The use of various alternate media is described, for example, in the "Disk Format and Alternate Media" section beginning on page 32 of the application, particularly starting on page 34, line 1. Examples discussed include CD/hard-drive, MP-3 player/hard drive, two distinct CDs, etc.. Any of these cases require that the two portions of the data are obtained in distinct read process from each medium and then need to be synchronized and recombined. This is quite distinct from the prior art, such as Aoki, which is directed to the use of a single physical and logical medium. The present Amendment has added a number of new claims dependent on claims 7 and 71 that are drawn to some of these specific embodiments.

Consequently, for these reasons, as well as for the reasons given in the previous Office Action but not repeated here, claims 7 and 71 along with their dependent claims are believed allowable and it is respectfully submitted that a rejection of any of these claims based on Aoki is not well founded and should be withdrawn.

CD/CD-ROM and Multiple Logical Media Embodiments

As discussed above, all of Aoki's teachings are directed at a single logical medium on a single physical medium, where both the standard audio data and supplemental audio data area read as part of the same read process that is standard for the medium. Of the independent claims rejected in the present Office Action, claims 4 and 89 are drawn to embodiments where the first and second media are distinct logical media, as are newly added independent claims 107 and 117.

New claims 107 and 117 are respectively the same as original claims 7 and 71, but have the added the limitation "wherein the first and second media have distinct logical structures requiring differing read processes" to make more explicit that the claims refer to an embodiment based on distinct logical media. As with the multiple physical media embodiments, this is quite distinct from the prior art, such as Aoki, which is directed to the use of a single logical medium read in a single read process.

Consequently, for these reasons, as well as for the reasons given in the previous Office Action but not repeated here, claims 107 and 117 along with their dependent claims are believed allowable and it is respectfully submitted that a rejection of any of these claims based on Aoki is not well founded and should be withdrawn.

A primary embodiment of the present invention is based on the audio portion of a CD and the CD-ROM portion of the same physical optical disc. Independent claims 4 and 89 are drawn to such an embodiment, as are some of claims 107 and 117 dependent claims. Although both portions are placed on the same physical substrate (or physical medium), they are two different logical media, requiring separate reads (see, e.g., page 18, lines 7-21), and having different logical structures. The use of differing logical structures for the CD-ROM portion is described, for example, in the section of the present application entitled "Disk Format and Alternate Media", beginning at page 32, line 5.

Although believed allowable in their original forms for all of the reasons stated in the previous Amendment, claims 4 and 89 have been amended to further distinguish them from the prior art. Both of these claims now contain the limitation

storing additional audio data on said CD outside of said audio portion according to a distinct logical structure requiring a differing read process than the audio portion of the CD;

where the underlined portion has been added. This is again quite distinct from the prior art, such as Aoki, which is directed to the use of a single logical medium read in a single read process. Several dependent claims have been added with specifics on the "distinct logical structure".

Consequently, for these reasons, as well as for the reasons given in the previous Office Action but not repeated here, claims 4 and 89 along with their dependent claims are also believed allowable and it is respectfully submitted that a rejection of any of these claims based on Aoki is not well founded and should be withdrawn.

Dependent claims

Several of the dependent claims have also been amended. Aside from objected to claim 80, all of these changes relate to their dependency. The dependencies have been changed so that their base claim is now the multiple physical media embodiment, multiple logical media/same

physical medium embodiment, or both, as is appropriate for the particular limitations of each of these claims.

A number of the dependent claims are believed further allowable for their additional limitations, as discussed in the previous Amendment. To save space, however, these arguments will not be repeated here, as these claims are believed allowable due to the allowability of their base claims. The case of claim 79, however, is different and is discussed in the next section.

Claims 79 and 80

The previous Office Action rejected claims 79 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki and further in view of Moorer, U.S. patent number 6,0728,878. The present Office Action agreed with the Applicant that this rejection was not well founded, as Moorer is not applicable as prior art against the present application. Consequently, the Office Action indicated that claim 80 would be allowable if rewritten in independent form (as is done in the present Amendment) and issued a new rejection of claim 79.

The new rejection of claim 79, however, is exactly the same as the previous rejection of claim 79, but with use of Moorer as a secondary reference removed. That is, the present Office Action rejects claim 79 under 35 U.S.C. 103(a) as being unpatentable over the single reference of Aoki. Where the previous Office Action had found it necessary to cite a secondary reference to supply elements of claim 79 that it admits are not found in Aoki, as the secondary reference is not applicable as prior art against the present application, the current Office Action has simply omitted the secondary reference and issued a rejection under under 35 U.S.C. 103(a) based on a single reference.

Thus, claims 79 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki. This rejections under 35 U.S.C. 103(a) over only Aoki as a single reference is respectfully traversed. It is admitted in the Office Action that both of these claims recite some feature which the Aoki patent "does not specifically disclose". Yet there is no further reference or other evidence of prior art is presented to demonstrate that the overall claimed combinations including the elements missing from Aoki would have been obvious. The Office Action either summarily states that the elements missing from Aoki were well known. Assumptions have improperly been made by the Examiner as to what one ordinarily skilled in the art would have found obvious to do since there is no supporting evidence provided in the Office Action. It is respectfully

submitted that these rejections do not make the necessary *prima facie* case of obviousness, and that, on that basis, the rejection of claim 79 must further be withdrawn.

Additionally, the element of claim 79 that the Office Action admits is missing from Aoki ("the deriving from said N-channel audio signal a two channel representation is based upon a linear combination of a finite set of spatial harmonics"), is not what the Office Action claims is well know, but rather some sort of arrangement of speakers. Thus, in addition to improperly rejecting claim 79 under 35 U.S.C. 103(a) based on a single reference, the Examiner appears to be improperly using hindsight gained from the present application to construct the invention of claim 79.

Information Disclosure Statements

The Applicant again draws the Examiner's attention to a pair of Information Disclosure Statements filed on August 10, 2001, and June 19, 2000. No indication is given of these having been considered. Consideration of these Information Disclosure Statements is also respectfully requested.

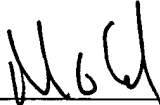
Conclusion

For any of these reasons, reconsideration of the Office Action's rejection of claims 4-14, 71-79, 81, 82, and 89-94, and consideration of new claims 107-123, are respectfully requested, and an early indication of their allowability is earnestly solicited.

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Respectfully submitted,



Michael G. Cleveland

Reg. No. 46,030

PARSONS HSUE & DE RUNTZ LLP

655 Montgomery Street, Suite 1800

San Francisco, CA 94111

(415) 318-1160 (main)

(415) 318-1166 (direct)

(415) 693-0194 (fax)

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